



Patent
Attorney's Docket No. 032567-002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
Hiroshi SUMYAMA et al.) Group Art Unit: 2622
Application No.: 09/238,163) Examiner: Madelein Anh Vinh Nguyen
Filed: January 28, 1999)
For: IMAGE FORMING APPARATUS)
)
)
)

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AMENDMENT/REPLY TRANSMITTAL LETTER

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Enclosed is a reply for the above-identified patent application.

- A Petition for Extension of Time is also enclosed.
- A Terminal Disclaimer and a check for [] \$55.00 (248) [] \$110.00 (148) to cover the requisite Government fee are also enclosed.
- Also enclosed is _____.
- Small entity status is hereby claimed.
- Applicant(s) request continued examination under 37 C.F.R. § 1.114 and enclose the [] \$370.00 (279) [] \$740.00 (179) fee due under 37 C.F.R. § 1.17(e).
- Applicant(s) previously submitted ___, on ___, for which continued examination is requested.
- Applicant(s) request suspension of action by the Office until at least ___, which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R. § 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.
- A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (146/246) is also enclosed.
- No additional claim fee is required.

[] An additional claim fee is required, and is calculated as shown below:

AMENDED CLAIMS					
	NO. OF CLAIMS	HIGHEST NO. OF CLAIMS PREVIOUSLY PAID FOR	EXTRA CLAIMS	RATE	ADDT'L FEE
Total Claims		MINUS =		× \$18.00 (103) =	
Independent Claims		MINUS =		× \$84.00 (102) =	
If Amendment adds multiple dependent claims, add \$280.00 (104)					
Total Amendment Fee					
If small entity status is claimed, subtract 50% of Total Amendment Fee					
TOTAL ADDITIONAL FEE DUE FOR THIS AMENDMENT					

[] A claim fee in the amount of \$ _____ is enclosed.

[] Charge \$ _____ to Deposit Account No. 02-4800.

The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: William C. Rowland
William C. Rowland
Registration No. 30,888

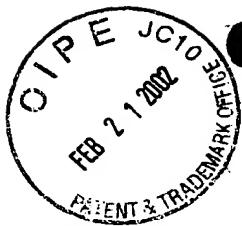
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For: IMAGE FORMING APPARATUS)

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3-2-02

RESPONSE

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Official Action dated November 23, 2001, the Examiner is respectfully requested to reconsider and withdraw the outstanding rejections of the application.

Claims 1-18 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,532,792, issued to *Hatori*, in view of U.S. Patent No. 5,152,001, issued to *Hanamoto*.

In the present application, there are three independent claims. Claim 1 defines an image forming apparatus that includes, among other elements, a controller for discarding the image data stored in a first memory when the command of discarding image data is generated by the command means, while maintaining the associated image forming conditions stored in a second memory. Claim 10 defines an image forming apparatus that includes, among other elements, a controller for discarding image data stored in an image

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memory when a command of discarding image data is generated by the command means, while maintaining the associated image forming conditions stored in the mode memory.

And, claim 16 defines an image forming method that includes, among other elements, erasing image data from an image memory in response to a command of discarding the image data, while maintaining associated image forming conditions in the memory.

Accordingly, one aspect of the present invention is the ability to discard image data, while maintaining associated image forming conditions in a memory.

The Examiner alleges that it would have been obvious to combine the teachings of *Hattori* with *Hanamoto*.

Applicants dispute the propriety of the combination of *Hattori* and *Hanamoto*. *Hanamoto* relates to an analog copying machine that is not capable of, and has no need, to store image data. The original image is simply reflected by mirrors from the original document onto the photosensitive drum. See 12, 13, 15 in Fig. 1. On the other hand, *Hattori* discloses a laser printer that does store and use digital image data. Accordingly, since *Hanamoto* has nothing do to with laser printers, it would not have been obvious for someone looking to improve the digital laser printer of *Hattori* to combine features of the *Hanamoto* analog copier control system with the digital laser printer of *Hanamoto*.

Furthermore, *Hattori* relates to canceling a printing job and deleting unused data related to that printing job. See column 4, lines 60 - 64. In contrast to *Hattori*, *Hanamoto* does not relate to canceling a job, but merely interrupting a first job so that a second (interrupt) job can be run before restoring the running of the first job. The concept of

temporarily interrupting a job is significantly different than canceling a job and deleting the data therein. Accordingly, one of skill in the art looking to improve a cancellation feature of a digital image laser system would not be motivated to look to an interrupt procedure in an analog copying device.

Most importantly, even if the references were combined, the result would not be the present invention. For example, even the official action only makes reference to maintaining the memory forming conditions "after the *interruption* of the printing process". See the last line of page 3 of the Official Action. Accordingly, even the Official Action, after improperly combining the two references, does not indicate that the *claimed* invention is taught or suggested. At best, the Official Action alleges that saving memory forming conditions after an interruption, not a discarding, would be suggested. Accordingly, even if the combination is made, the present invention is still not taught or suggested.

Specifically, the Examiner has not shown, nor does the Examiner allege, that the prior art teaches or suggests the claimed invention, which includes the ability to discard image data stored in an image memory, while maintaining associated image forming conditions.

The Examiner acknowledges that *Hattori* does not even teach a memory for storing image forming conditions. However, the Examiner concludes that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to consider a memory in *Hattori* for storing image forming conditions. However, the

Examiner does not allege that *Hattori* on its own, teaches the ability to discard image data, while maintaining associated image forming conditions in a memory. The Examiner further alleges that *Hattori* teaches that a printing operation may be interrupted, and when the print process is restarted, a laser driving signal from a laser driving signal output port OPO is supplied to the driving circuit. However, *Hattori* does not teach "interrupting" a process, *Hattori* only relates to canceling a print job, not interrupting the print job.

Furthermore, the Examiner alleges that *Hanamoto* teaches that the memory forming conditions are maintained after the interruption of the printing process. However, *Hanamoto* is not actually a printer, but an analog copier. From this, the Examiner alleges that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the teaching of saving the stored image forming conditions after the interruption of the printing process in *Hanamoto* to *Hattori*, since *Hattori* teaches that after the interruption of the printing process and the printing process is started again, the print process returns to the main routine of the previous printing process.

However, the Examiner has not pointed to any teaching in either of the reference that relates to the discarding of image data. Discarding of image data is different from the mere interruption of the printing process. Specifically, even though the printing process is interrupted, the image data is not necessarily discarded.

Accordingly, none of the references taught or suggest by the Examiner, either singly or in combination, teaches the claimed inventions.

Application No. 09/238,163
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Page 5

In the event that there are any questions concerning this response or the application in general, the Examiner is respectfully requested to telephone the undersigned so that prosecution of the application may be expedited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

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